

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 16-19 and 21-27 are pending in the present application. Claims 16-19 and 21-27 have been amended to more particularly point out and distinctly claim the present invention. Claims 16-18 are directed to a method for increasing the oil content of an oil-producing plant. Claim 19 is directed to a nucleotide sequence encoding for an enzyme that catalyzes the transfer of a fatty acid from acyl-CoA. Claims 21-25 are directed to transgenic plants having a nucleotide sequence according to claim 19. Claims 26 and 27 relate to methods for increasing the oil content of an oil-producing organism. Claim 20 has been canceled.

In the outstanding Official Action, claims 19 and 21-25 were rejected under 35 USC §112, first paragraph, for allegedly being based on an insufficient written description.

In imposing the rejection, the Official Action alleged that the present disclosure does not disclose sequences derived from SEQ ID NO:1, the *Saccharomyces cerevisiae* gene, or sequences which encode proteins other than SEQ ID NO:2. However, the Examiner's attention is respectfully directed to amended claim 19. Claim 19 now recites that the claimed nucleotide sequence

encodes for an enzyme having an enzyme amino acid sequence comprising SEQ ID NO: 2. This recitation was previously found in claim 20. As the Examiner is aware, the outstanding Official Action determined that claim 20 was fully supported by the present disclosure.

As a result, applicants believe that the contentions of the outstanding Official Action have been obviated. Indeed, applicants believe that claim 19 is clearly supported by a sufficient written description. As to claims 21-25, applicants note that claims 21-25 recite the nucleotide sequence according to amended claim 19.

Thus, upon reviewing the present disclosure, it is believed that the specification sufficiently describes the claimed invention in such full, clear, concise and exact terms so that one of ordinary skill in the art would recognize that applicants were in possession of the claimed invention at the time the application was filed.

Claims 16-18 and 27 were also rejected under 35 USC §112, first paragraph, for allegedly being based on a non-enabling disclosure. It is believed that the present amendment obviates this rejection.

However, applicants believe that the outstanding Official Action fails to meet its burden in showing that the claimed invention is not enabled by the present disclosure.

Indeed, the Examiner is respectfully reminded that it is a well founded principle that any assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubt so expressed.

As a matter of law, the expressed teaching of the patent specification cannot be controverted by mere speculation and unsupported assertions on the part of the Patent Office. As stated by the Court of Customs and Patent Appeals in the case of *In re Dinh-Nguyen and Stenhagen*, 181 USPQ 46 (CCPA 1974):

Any assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubt so expressed. 181 USPQ at 47.

Thus, such a standard must be applied with great care when the position of the Patent Office is contrary to the teachings of the specification. When reviewing the position of the Patent Office on this point, it is apparent that no evidence is adduced that is in any way inconsistent with the teaching of the present disclosure.

In fact, applicants believe that the claimed invention is enabled by the present disclosure. As further evidence of this assertion, the Examiner's attention is directed to an additional declaration by Dr. Oliver Oswald. The declaration

provides additional evidence that the disclosure of the patent application is enabling for the claimed invention.

Moreover, applicants respectfully remind the Examiner that while some experimentation may be needed to transform oil-producing plants other than *Arabidopsis* and yeast with the current sequences, applicants note that the claimed sequences are clearly recited in the present disclosure. It would not be the case that one skilled in the art would have to isolate a multitude of unknown sequences or evaluate how numerous sequences would alter the phenotype of any and all plants.

Thus, while a minimum amount of experimentation may be needed to practice the claimed invention, it is believed that this experimentation would be merely routine and not unduly extensive. It is believed that the present disclosure enables the claimed invention. Indeed, as noted above, the Official Action fails to present any evidence to the contrary. As a result, it is believed that claims 16-18 and 27 are enabled by the present disclosure.

Claims 16-25 were rejected under 35 USC §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention.

The outstanding Official Action rejected claims 16, 26, and 27 for not reciting that the oil content of the plant has

actually been increased. While applicant believes that claims 16, 26, and 27 are definite to one skilled in the art, in the interest of advancing prosecution, claims 16, 26, and 27 have been amended to again recite that the oil content of the plant has actually been increased.

Claim 19 was rejected for reciting the term "is derived from". Claim 19 has been amended so that this phrase is no longer recited. Claim 19 has also been amended so that the phrase "encodes an enzyme" is recited. Applicants would like to thank the Examiner for the suggestion as to how to overcome the rejection. As noted above, claim 20 has been canceled.

Thus, it is believed that claims 16-19 and 21-27 are definite to one of ordinary skill in the art.

Claims 19 and 21-25 were rejected under 35 USC §102(b) as allegedly being anticipated by LARDIZABAL et al. It is believed that the present amendment obviates this rejection.

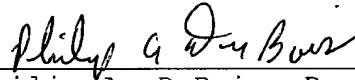
As noted above, claim 19 now recites that the claimed nucleotide sequence encodes for an enzyme having an enzyme amino acid sequence comprising SEQ ID NO: 2. This recitation was previously found in claim 20. In the outstanding Official Action, the Examiner indicated that claims 16-18 and 20-27 were free of prior art. Thus, it is believed that LARDIZABAL et al. fail to anticipate or render obvious claim 19.

In view of the present amendment and the foregoing remarks, therefore, it is believed that the present application is now in condition for allowance, with claims 16-19 and 21-27, as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- a 37 CFR 1.132 Declaration